

**REMARKS**

Claims 1, 52 and 62 have been amended to require the presence of from 5 % to 60 % non-volatile silicone compound. Support for these amendments exists throughout the entire specification, particularly in original claim 30. Claims 29, 30 and 80, which were directed to similar subject matter, have been canceled.

Claims 53, 55, 60 and 61 have been amended to clarify that claims 53-57, 60 and 61 are method claims requiring application of the composition set forth in claim 1. That is, these method claims ultimately depend from claim 1.

New claims 98-100 require that the compositions be transfer-resistant. Support for these claims exists throughout the entire specification.

New claims 101 and 102 require the presence of a transfer-resistant composition (lipstick) containing 0-5% volatile oil. Support for these claims exists throughout the entire specification.

Claims 1-28, 31-42, 44-79 and 81-102 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration.

The Office Action issued a Restriction Requirement indicating that claims 53-57, 60 and 61 have been withdrawn from consideration. In view of the above amendments which make clear that the method claims in question ultimately depend from claim 1 and, thus, require application of the composition set forth in claim 1, Applicant respectfully submits that the Restriction Requirement has been rendered moot. Accordingly, Applicant respectfully requests its reconsideration and withdrawal.

The Office Action rejected claims 1-3, 5-10, 11, 18, 29-31, 35-40, 42, 43, 46, 48, 50-52, 58, 59, 62-70 and 82-97 under 35 U.S.C. §103 as obvious over U.S. patent

5,690,918 ("Jacks") in view of U.S. patent 6,126,951 ("Fogel"), claims 1-10, 24-30, 32-35, 37-42, 45-52, 62-69, 80, 82, 83 and 85-97 as obvious over U.S. patent 5,738,841 ("Mellul") in view of Fogel, and claims 11-23 as obvious over Mellul and Fogel in view of JP 63119412 ("JP 412"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Regarding the § 103 rejection based on Jacks and Fogel, Jacks relates to transfer-resistant compositions. Typically in such compositions, volatile oil evaporates after composition application. After the volatile solvent/oil has evaporated, the remaining composition forms a dry, transfer-resistant film. Thus, the presence of volatile solvent and its evaporation from the applied formulation enables the formation of transfer-resistant films. Jacks recognizes this crucial role volatile oils play in his transfer-resistant compositions, stating that volatile oils contribute to the "wear characteristics" of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

One of the primary practical differences between the claimed invention and Jacks is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks requires the presence of a substantial amount of volatile oil. One skilled in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks to remove or reduce volatile solvent from Jacks's compositions because removing volatile solvent would affect the wear-characteristics of these transfer-resistant products.

Fogel does not compensate for Jacks's deficiencies. Fogel teaches that volatile silicones should be replaced with moisturizers/emollients which will not evaporate like volatile silicones. (Col. 1, lines 5-30). One skilled in the art, seeking to produce a transfer-resistant composition like Jacks's, would not be motivated to make such a substitution in Jacks's compositions because Jacks wants evaporation of a volatile oil to occur so that a transfer-resistant film will be formed. Replacing a volatile oil with a non-volatile oil would defeat Jacks's purpose. Thus, combining Fogel and Jacks would not yield the claimed invention.

Regarding the rejection based on Mellul, Fogel, and JP 412, Mellul does not render the present invention obvious. Nowhere does Mellul teach one skilled in the art to use the specific combination of 0.1-30% inert particulate phase **and** 0.5-60% non-volatile silicone compound. Moreover, Mellul does not relate to transfer-resistant compositions, let alone transfer-resistant lipsticks. Rather, Mellul discloses non-transfer-resistant compositions containing 0% inert particulate phase or 48% or more inert particulate phase,<sup>1</sup> and teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing the appearance and sensation problems associated with transfer-resistant compositions, particularly lipsticks, would not be motivated by Mellul to selectively produce a composition having from 0.1-30% inert particulate phase **and** 0.5-60% non-volatile silicone compound with the expectation that such a composition would result in a transfer-resistant composition which does not have a matte appearance or the sensation of dryness, tautness and/or discomfort.

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<sup>1</sup> In this regard, Applicant notes that pigments do not constitute fillers/inert particulate phase. (See, specification at pages 20 and 21; Mellul at col. 2, line 43).

What's more, neither Mellul, Fogel, nor JP 412 suggests modifying Mellul's compositions to yield transfer-resistant compositions, particularly lipsticks, containing both particulate matter and non-volatile silicone compounds in the required concentrations.

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be reconsidered and withdrawn.

The Office Action also rejected claims 1-42, 44-52, 58, 59, 83, 85, 86, 91, 96 and 97 under 35 U.S.C. §112, second paragraph, as being indefinite for not specifically setting forth the amount of volatile silicone oil present. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

The rejected claims require the presence of at least one volatile oil, wherein said volatile oil is present in an amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material. The conditions set forth in these claims are known conditions associated with volatile oils in transfer-resistant compositions. (See, for example, page 4, lines 1-13 of the present application). Because they are known conditions, one skilled in the art would easily be able to determine their existence upon application of a composition which, in turn, means that one skilled in the art would easily be able to determine if sufficient volatile oil were present to be causing such conditions. Conversely, it would merely be a matter of routine experimentation for one skilled in the art to determine the concentration of volatile oil necessary in a particular composition to cause the identified conditions.

Thus, the rejected claims are definite under § 112 because one skilled in the art would easily be able to determine whether the required amount of volatile oil were present in a particular composition.

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. § 112 be reconsidered and withdrawn.

The Office Action also rejected claims 62-82, 84, 87-90 and 92-95 under the judicially-created doctrine of double patenting over claim 9 of U.S. patent 6,326,012. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Claim 9 of the '012 patent requires the presence of a volatile hydrocarbon based-oil, a synthetic wax having specified properties, and silicone gum, whereas the rejected claims in the pending application require the presence of not only a non-volatile silicone compound, but also an inert particulate phase and a non-volatile hydrocarbon based-oil. Moreover, the presence of a volatile oil is optional. Thus, the rejected claims do not require the presence of a synthetic wax or a volatile oil, and claim 9 of the '012 patent does not require the presence of an inert particulate phase or a non-volatile hydrocarbon oil. Accordingly, the double patenting rejection is improper and should be withdrawn.

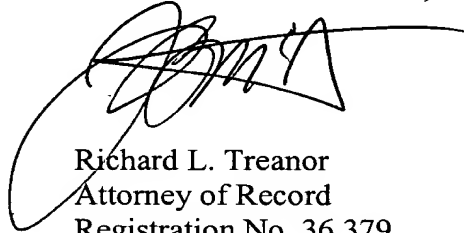
Application No. 09/941,869  
Response to Office Action dated January 28, 2004

Applicant believes that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'R. Treanor', is written over a horizontal line.

Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number

**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220